

REMARKS

By this reply, claims 1, 3, 10, 18, 19, 22, and 23 have been amended; claims 2 and 24 have been cancelled; and claims 28 and 29 have been added. Accordingly, claims 1, 3-23, and 25-29 are pending in this application. No new matter has been introduced by this reply.

In the outstanding Office Action, claims 1-27 were rejected under 35 U.S.C. § 112, second paragraph for allegedly failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention; claims 1-6, 8, 10, 11, 14-24, and 27 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,732,383 to Ferrari et al. ("Ferrari 383") in view of U.S. Patent No. 4,911,445 to Ferrari et al. ("Ferrari 445")¹; and claims 7, 12, 13, 25, and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ferrari 383 and Ferrari 445 in view of U.S. Patent Nos. 5,096,194 to Yong et al. ("Yong") and 5,398,928 to Rudell et al. ("Rudell").²

Claims 1, 3, 18, 22, and 23 have been amended to remove the phrase "substantially coupling." In light of these amendments, Applicant submits that the rejection of claims 1-27 under 35 U.S.C. § 112, second paragraph has been rendered

¹ While the Office Action lists claims 1-6, 8, 10, 11, 14-24, and 27 as being rejected under 35 U.S.C. § 102(b), it is apparent from pages 3 and 4 of the Office Action that the rejection was based on obviousness under 35 U.S.C. § 103(a), not anticipation under 35 U.S.C. § 102(b). Thus, our remarks address claims 1-6, 8, 10, 11, 14-24, and 27 as being rejected under 35 U.S.C. § 103(a) as being unpatentable over Ferrari 383 in view of Ferrari 445.

² While the Office Action Summary attached to the Office Action indicates that claim 9 is rejected, the Office Action fails to provide grounds for rejection of rejecting claim 9. If claim 9 is indeed rejected, Applicant requests an explanation of the grounds for rejection in a subsequent Office Action.

moot. Accordingly, Applicant requests the withdrawal of the indefiniteness rejections of claims 1-27.

Applicant respectfully traverses the rejection of claims 1-6, 8, 10, 11, 14-24, and 27 as being rejected under 35 U.S.C. § 103(a) as being unpatentable over Ferrari 383 in view of Ferrari 445. Applicant submits that the Office Action has failed to establish the *prima facie* case of obviousness required to reject these claims.

Amended independent claim 1 recites, *inter alia*, “[a] dampening device for ball game rackets . . . the dampening device can be fixed to at least two longitudinal strings of a ball game racket, the dampening device being configured to embrace opposing sides of each of the at least two longitudinal strings without fully encompassing each of the at least two longitudinal strings.”

Ferrari 383 discloses an absorbing bar 23 secured to a racquet 11 by weaving absorbing bar 23 over and under alternate vertical strings 20a and 20b. See Ferrari 383, column 3, lines 48-50; and FIGS. 1 and 2. This weaving firmly secures absorbing bar 23 to the racquet to prevent absorbing bar 32 from becoming dislodged during play. See *Id.* at column 2, lines 29-31. As a result of the weaving, when absorbing bar 23 is coupled to vertical strings 20a and 20b, absorbing bar 23 does not embrace opposing sides of each of vertical strings 20a and 20b. Rather, in Ferrari 383, absorbing bar 23 contacts a single side of vertical string 20a, and a single side of vertical string 20b. Thus, since absorbing bar 23 does not embrace opposing sides of each of vertical strings 20a and 20b, Ferrari 383 fails to teach or suggest “the dampening device being configured to embrace opposing sides of each of the at least two longitudinal strings,” as recited in claim 1.

Further, Ferrari 383 teaches that the weaving of absorbing bar 23 above and below alternative vertical strings is what secures absorbing bar 23 to racquet 11. See *Id.* If absorbing bar 23 were somehow modified to embrace opposing sides of each of vertical strings 20a and 20b, then absorbing bar would not be interwoven through the strings in the same way. This would render absorbing bar 23 unsatisfactory for its intended purpose, and/or would change its principle of operation, since it would not be firmly secured, as by weaving, per the requirements of Ferrari 383. Thus, such a modification would not have been obvious. See MPEP 2143.01.

Ferrari 445 fails to remedy the above-described deficiencies of Ferrari 383, nor does the Office Action cite Ferrari 445 for such a purpose. See Office Action, page 4. Ferrari 445 discloses a dampening device 12 including a hollow tubular member 28 interwoven through longitudinal strings 18 of a racket 10 in a manner similar to absorbing bar 23 in Ferrari 383. See Ferrari 445, column 3, lines 61-66; and FIG. 1. The interweaving helps to keep tubular member 28 in a slightly stretched condition, helping to retain dampening device 12 on racket 10. See *Id.* at column 5, lines 10-15. As such, Ferrari 445 is merely repetitive of features already shown in Ferrari 383, and does not cure the above-described deficiencies. For all of these reasons, claim 1 is not *prima facie* obvious over Ferrari 383 in view of Ferrari 445. Reconsideration is requested.

Claims 2-6, 8, 10, 11, 14-23, and 27, each depend from amended independent claim 1, and are allowable for at least the reasons stated above that claim 1 is allowable. In addition, each of the dependent claims recites unique combinations that

are neither taught nor suggested by the cited art, and therefore each is also separately patentable.

In light of the amendment to claim 1, Applicant also respectfully requests withdrawal of the rejection of claims 7, 12, 13, 25, and 26 under 35 U.S.C. § 103(a) as being unpatentable over Ferrari 383 and Ferrari 445 in view of Yong and Rudell. Applicant submits that the Office Action fails to establish the *prima facie* case of obviousness required to reject these claims. For one thing, claims 7, 12, 13, 25, and 26 each depend from amended independent claim 1. Yong and Rudell fail to remedy the deficiencies of Ferrari 383 and Ferrari 445 with respect to amended independent claim 1, nor are Yong and Rudell cited for such a purpose. Therefore, claims 7, 12, 13, 25, and 26 are allowable for at least the same reasons stated above that amended independent claim 1 is allowable. In addition, these dependent claims recite unique combinations that are neither taught nor suggested by the cited art, and therefore each is also separately patentable.

New independent claim 28, while of different scope, recites limitations similar to those recited in amended independent claim 1. For example, claim 28 recites, *inter alia*, “the dampening device is configured to be fixed to at least two longitudinal strings of a ball game racket, the dampening device being configured to exert a compressive force on the at least two longitudinal strings without fully encompassing the at least two longitudinal strings.” The cited references fails to disclose or suggest these features. The timely allowance of claim 28 is respectfully requested.

New independent claim 29 recites, *inter alia*, “the dampening device is configured to be fixed to at least two adjacent longitudinal strings of a ball game racket, the

dampening device being configured to embrace less than a full circumference of each of the at least two adjacent longitudinal strings, with an interior surface of the dampening device facing the at least two adjacent longitudinal strings, and an exterior surface of the dampening device facing away from the at least two adjacent longitudinal strings.” The cited references fail to disclose or suggest these features. Accordingly, the timely allowance of claim 29 is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.



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By: _____
Thomas Y. Ho
Reg. No. 61,539